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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/029,852

12/31/2001

Ronald B. Hopkins

RHOP 2

5318

7590

12/31/2003

John H Thomas PC
1561 East Main Street
Richmond, VA 23219

EXAMINER

ODLAND, KATHRYN P

ART UNIT

PAPER NUMBER

3743

DATE MAILED: 12/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/029,852

Applicant(s)

HOPKINS ET AL.

Examiner

Kathryn Odland

Art Unit

3743

-- **Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --**
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102/103

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 3, 4, 6, 7, and 10-12 are rejected under 35 U.S.C. 102(a and/or e)/103(a) as being anticipated by Doran in US Patent No. 6,179,799.

Regarding claim 1, Doran discloses an orthotic device (10) for promoting supination and pronation having a forearm enclosure (26 and via straps such as 27) adapted to *substantially* wrap around a forearm, as seen in figures 1-3; a forearm support member (such as 30, 33, etc. and associated components) adapted to slidably receive the forearm enclosure (as recited in column 3) wherein the support member (portion at 70) wraps *partially* around the forearm enclosure (at connection of 70 and 26); and a tensioning member (such as 71A, 71B), wherein a rotational force of supination or pronation will be created on the forearm enclosure depending on the direction which the tensioning member is extended, as recited in column 3, lines 2-4, with emphasis on column 3, lines 44-55 and seen in figure 3. Although a post mounted on the forearm enclosure, an anchor mounted on the support member, wherein the

tensioning member is connected on one end to the anchor and on the other end to the post is not explicitly recited, it is inherent that a connection is required. Thus, given a reasonably broad interpretation of post and anchor the connection means of Doran can be considered inherently a post and anchor.

Further, given a reasonably broad interpretation of a forearm enclosure and support member, the invention of Doran would read on the claim limitation. However, Hamersly in US Patent No. 5,683,353 has been cited below for a structure that more closely resembles that shown in the figures of the current application, and thus, would also be considered obvious.

Regarding claim 3, Doran discloses that as applied to claim 1, as well as, a tensioning member that is an elastic material, as recited in column 3, lines 44-55.

Regarding claim 4, Doran discloses that as applied to claim 1, as well as, a tensioning member that is of an inelastic material, as recited in column 3, lines 44-55.

Regarding claim 6, Doran discloses that as applied to claim 1, as well as, an upper arm support member (such as that at 25) connected on one end to the forearm support member and adapted to substantially wrap around and support an upper arm, as seen in figure 1.

Regarding claim 7, Doran discloses that as applied to claim 1, as well as, an upper arm support member that is hingedly connected to the forearm support member, as recited in column 2, lines 45-50.

Regarding claim 10, Doran discloses that as applied to claim 7, as well as, an angle of connection of the upper arm support member and the forearm support member that is variable, as recited in column 2.

Regarding claim 11, Doran discloses an orthotic device (10) for promoting supination and pronation having a forearm enclosure (such as 26 and via straps such as 27) adapted to *substantially* wrap around a forearm; a forearm support member (such as 30, 33, etc. and associated components) adapted to slidably receive the forearm enclosure wherein the support member wraps *partially* around the cast (as recited in column 3); tensioning means (71A, 71B) having a first and a second end; and means for attaching the tensioning means on the first end to the forearm enclosure and on the second end to the forearm support member, wherein a rotational force of supination or pronation will be created on the forearm enclosure depending on the direction which the tensioning means is attached to the forearm support member and the forearm enclosure, as recited in column 3, lines 2-4, with emphasis on column 3, lines 44-55 and seen in figure 3. Further, it is necessary to have an attachment.

Regarding claim 12, Doran discloses a forearm enclosure (such as 26 and via straps such as 27) adapted to *substantially* wrap around a forearm; a forearm support member (such as 30, 33, etc. and associated components) adapted to slidably receive the forearm enclosure (as recited in column3), wherein the support member is adapted to wrap *partially* around the forearm enclosure; and a tensioning member (71A, 71B0. Although a post mounted on the forearm enclosure, an anchor mounted on the support member, wherein the tensioning member is connected on one end to the anchor and on the other end to the post is not explicitly recited, it is inherent that a connection is required. Thus, given a reasonably broad interpretation of post and anchor the connection means of Doran can be considered inherently a post and anchor.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2, 5, 8, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doran in US Patent No. 6,179,799.

Regarding claim 2, Doran discloses that as applied to claim 1. However, Doran do not explicitly recite a plurality of posts mounted at different locations on the forearm enclosure. On the other hand, it would be obvious to one with ordinary skill in the art to have multiple attachment locations for the purpose of adjusting tension.

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Regarding claim 5, Doran discloses that as applied to claim 1. However, Doran do not explicitly recite a tensioning member that has an adjustable length. On the other hand, it would also be obvious to one with ordinary skill in the art to make the tensioning member be adjustable for it has been held that it only requires routine skill in the art to make something formerly not adjustable, adjustable.

Regarding claim 8, Doran discloses that as applied to claim 6. However, Doran do not explicitly recite an upper arm support member is fixedly connected to the forearm support member at a predetermined angle. However, the specification of the current application does not demonstrate the criticality of an upper arm support member is fixedly connected to the forearm support member at a predetermined angle. Further, claims are drawn to a support member that is hingedly connected. Thus, a fixed and hinged attachment can be considered equivalents.

Regarding claim 9, Doran as modified discloses that as applied to claim 8. However, Doran do not explicitly recite a predetermined angle that is substantially 90. However, the specification of the current application does not demonstrate the criticality of a predetermined angle that is substantially 90. Further, claims are drawn to an angle that is varied. Thus, a predetermined angle that is substantially 90 can be considered an equivalent to the variable angle.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure are as follows: US 2003/0144620; US 2003/0065281; US Patent No. 6,537,237; US Patent No. 5,683,353; and US Patent No. 4,559,932.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathryn Odland whose telephone number is (703) 306-3454. The examiner can normally be reached on M-F (7:30-5:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry A Bennett can be reached on (703) 308-0101. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9302.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

KO

Henry Bennett
Supervisory Patent Examiner
Group 3700

